



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,131	12/28/2001	Robert A. Dunstan	10559-549001	1605

20985 7590 07/20/2006

FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

LEMMA, SAMSON B

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/034,131	Applicant(s) DUNSTAN ET AL.	
	Examiner Samson B. Lemma	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2132

DETAILED ACTION

1. This office action is in replay to an amendment filed on April 12, 2006.

Claims 1-30 are pending/examined.

Response to Arguments

2. Applicant's remark/arguments filed on April 12, 2006 regarding independent **claims 1, 14, 24, 27 and 29** have been fully considered but they are not persuasive.

Applicant first argument is based on the limitation in the independent claim 1, 14, 24, 27 and 29.

Applicant argument is based on the motivation used to combine the two references used towards the independent claims **1, 14, 24, 27 and 29**.

Applicant argued that, the motivation for modifying/combining **Hurtado (U.S. Patent No. 6,611,812) with Thompson (U.S. Patent No. 5,406,627)** is improper because it lacks supporting evidence.

Examiner disagrees with this argument, Examiner would point out that It is not necessary that the reference actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The text for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. See In re Sheckle, 168 USPQ 716 (CCPA 1971) In re McLaghlin 170 USPQ 209 (CCPA 1971). In re Young 159 USPQ 725 (CCPA 1968).

Art Unit: 2132

In order to clarify how each and every limitation of the independent claims is disclosed by the combination of the two references, namely **Hurtado** and **Thompson** (Examiner would map each and every limitations of the independent claims with the references used in the rejection as follows). **Referring to the independent claims 1,14, 24, 27 and 29 , Hurtado discloses a method comprising: transmitting a decoder core to be used with a predefined content decoder, the decoder core for causing the predefined content decoder to decrypt an encrypted version of digital content.**

[column 6, lines 10-14] (Once the end user receive permission from the a clearing house after requesting permission, it will be able to access/get the decryption key stored in the container sent/transmitted to the end user/decoder. The end user by using the decrypting key stored in the container will decrypt/reproduce/play the previously encrypted content. The method to delivery encrypted digital content to the end user system for the playing/reproducing of the content is also explained on column 5, lines 59-60 and receiving a secure container/storage/medium containing the decrypting key for decrypting the previously encrypted content is also explained on column 5, lines 66-column 6, line 1; column 6, lines 6-10)

Hurtado does not explicitly disclose

The decoder core comprising instructions for causing the predefined content decoder to decrypt an encrypted version of digital content.

However, In the same field of endeavor, **Thompson** discloses

The system further comprising a digital data encrypting system for encrypting data and transmitting said encrypted data and said instructions to said digital data decrypting system, said instructions identifying a decryption key within said memory means to be used as an active key to decrypt said encrypted data.

[Column 43, lines 9-15]

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of transmitting instructions for

Art Unit: 2132

causing the predefined decrypting system to decrypt the encrypted version of content as per teachings **Thompson** into the method as taught by **Hurtando** in order to **improve an encryption system and consequently makes it difficult for unauthorized decryption of content.**[See **Thompson**, column 2, lines 43-47]

Therefore all the limitation of the independent claims are undoubtedly disclosed by the combination of the references and the rejection is maintained until the applicant amend the independent claims and successfully overcome the rejection without introducing new matters.

The next argument presented by the applicant is towards the dependent claims. Examiner disagrees with the argument as the dependent claims stands and falls with the corresponding independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-30** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Hurtado et al.** (hereinafter referred to as **Hurtado**) (U.S. Patent No. 6,611,812 B2) in view of **Thompson et al** (hereinafter referred to as **Thompson**) (U.S. Patent **5,406, 627**)

Art Unit: 2132

5. **As per claim 1,14, 24 and 27-29**, **Hurtando** discloses a method comprising: transmitting a decoder core to be used with a predefined content decoder, the decoder core for causing the predefined content decoder to decrypt an encrypted version of digital content. [column 6, lines 10-14] (Once the end user receive permission from the a clearing house after requesting permission, it will be able to access/get the decryption key stored in the container sent/transmitted to the end user/decoder. The end user by using the decrypting key stored in the container will decrypt/reproduce/play the previously encrypted content. The method to delivery encrypted digital content to the end user system for the playing/reproducing of the content is also explained on column 5, lines 59-60 and receiving a secure container/storage/medium containing the decrypting key for decrypting the previously encrypted content is also explained on column 5, lines 66-column 6, line 1; column 6, lines 6-10)

Hurtando does not explicitly disclose

The decoder core comprising instructions for causing the predefined content decoder to decrypt an encrypted version of digital content.

However, In the same field of endeavor, **Thompson** discloses

The system further comprising a digital data encrypting system for encrypting data and transmitting said encrypted data and said instructions to said digital data decrypting system, said instructions identifying a decryption key within said memory means to be used as an active key to decrypt said encrypted data. [Column 43, lines 9-15]

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of transmitting instructions for causing the predefined decrypting system to decrypt the encrypted version of content as per teachings **Thompson** into the method as taught by **Hurtando** in order to **improve an encryption system and consequently makes it difficult**

for unauthorized decryption of content.[See Thompson, column 2, lines 43-47]

6. **As per claim 2 and 30, the combination of Hurtando and Thompson discloses a method as applied to claim above. Furthermore Hurtando discloses the method further comprising receiving a request to access digital content, wherein the transmitting comprises transmitting in response to the request.**[column 6, lines 10-14] (End user receive permission from the a clearing house after requesting permission then it will be able to access/get the decryption key stored in the container received or sent/transmitted to the end user/decoder by the clearing house. The end user by using the decrypting key stored in the container will decrypt/reproduce/play the previously encrypted content.)

7. **As per claim 3-9; 20-23, the combination of Hurtando and Thompson discloses a method as applied to claim above. Furthermore Hurtando discloses the method further comprising receiving a request to access digital content, wherein the transmitting comprises transmitting in response to the request and the decoder core further comprising a decryption key.**[column 6, lines 10-14 and column 5, lines 66-column 6, line 14] (The end user is controlled from the reproduction/playing of the content/data in accordance with information stored in the secured container. First the end user gets authentication permission to access the decryption key stored in the secured container to decrypt the content. The clearing house, based on the authentication result, will judge whether or not the end user is authorized to get the permission to access the decryption key stored in the container/storage/medium. If the end user passes the authentication process, it is permitted by the, clearing house to decrypt the content. And the end user will receive a secure container encrypted using the encrypting key of the end user for decrypting the

Art Unit: 2132

previously encrypted content. The end user using the encrypting key access the decryption key for decrypting the content.)

8. **As per claim 10-11**, the combination of **Hurtando and Thompson** discloses a method as applied to claim above. Furthermore Hurtando discloses the method wherein the content-specific obfuscated software corresponds to a content-specific encryption algorithm, the method further comprising: **encrypting the requested digital content using the content-specific encryption algorithm; and delivering the encrypted digital content.**[column 5, lines 59-60] **(method to delivery encrypted digital content to the end user system for the playing/reproducing of the content)**

9. **As per claim 12-13 & 25-26**, the combination of **Hurtando and Thompson** discloses a method as applied to claim above. Furthermore **Hurtando** discloses the method wherein the predefined content decoder comprises a previously delivered media player. [column 6, lines 10-14] **(Once the end user receive permission from the a clearing house, it will be able to access the decryption key stored in the container received or sent to the end user. The end user by using the decrypting key stored in the container wil decrypt/reproduce/play the previously encrypted content.)**

10. **As per claim 15-19**, the combination of **Hurtando and Thompson** discloses a method as applied to claim above. Furthermore **Hurtando** discloses the method wherein receiving a decoder core comprises receiving the encrypted digital content and the decoder core together.[[column 5, lines 59-60;column 5, lines 66-column 6, line 1; column 6, lines 6-10] **(As shown on column 5, lines 59-60 the method of delivering encrypted digital content to the end user system for the playing/reproducing of the content is explained . Furthermore receiving a secure container/storage/medium containing the decrypting key for decrypting the previously encrypted content is also disclosed and meets the recitation of the claim.)**

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

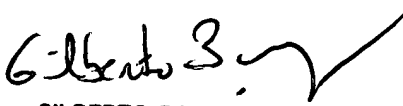
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private

Art Unit: 2132

PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S.L.
06/16/2006


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100